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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,797	12/20/2001	Masao Watanabe	P21644	8686

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EXAMINER
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RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/926,797

Applicant(s)

WATANABE ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 24,38-41, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claim 24, it is not clear as to what statutory class of invention this claim falls into. Is this a method claim or an apparatus claim. By reciting a method step of having the control unit display information (claim 24), this implies that the claim is a method, but the preamble says it is a system claim (apparatus). This is a mixing to two distinct classes of invention and renders the claim as non-statutory. Applicant cannot recite structure in apparatus claims and then recite method steps to using that recited structure as this renders the claims non-statutory.

For claim 38-41, the claim is directed to a program only, which is not statutory. The program claim can be statutory if the program is claimed as being stored on a computer readable storage medium (excluding a signal as the storage medium) that when executed by a computer performs the following steps. A computer program alone is not statutory.

3. Claim 36 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2,4-6,13,19,24,36,37, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 2, it is not clear as to what the language “and causing the owner to present an indication for the enquiry” is attempting to define. What does this mean? What is an indication for an enquiry? It is not clear what an indication is. What is this? One wishing to avoid infringement would not know what this is and what scope this term has.

For claims 4,5,6, it is not clear what an “indication” is. What is an “indication” to the enquiry? One wishing to avoid infringement would not know what this is and what scope this term has.

For claim 13, this claim depends to itself, so the scope of this claim is not known. Applicant changed the dependency from 9 or 10 to be to claim 13, which is improper.

For claim 24, the first part of the claim is confusing and seems to end prematurely. The portion that reads “characterized in that said storage unit includes a second database in which position information of a plurality of vessels,” ends without actually reciting anything. What is being recited here? This is not clear. Also, it appears that applicant is claiming a method of using the recited structure of the system (apparatus) in an apparatus claim, which is not proper. One wishing to avoid

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infringement would not know if possession of the system would infringe the claim or if possession and performing the recited step would be infringement. Also, by reciting a method step of having the control unit display information, this makes it unclear as to what statutory class of invention this claim falls into. Is this a method claim or an apparatus claim? This is not clear.

For claim 19, it is not clear as to what is being claimed. What structure to the system is being recited here? This claim reads poorly and does not seem to claim anything. What is being claimed here?

For claims 36,37, it is not clear as to what applicant is claiming, an apparatus or a method? The preamble indicates a server is being claimed, which would be an apparatus, but the entire body of the claim is directed to a use of the server, which implies that it is a method claim. Claim 36 provides for the use of a server but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. First it is not clear as to whether or not the claim is an apparatus claim or a method claim, and then if it is a method claim, what steps are being recited? Also, if applicant does intend to recite an apparatus (the server), applicant should note that there is not one single recitation to any structure at all. Either way, whether this is a method or apparatus claim, it is not clear what is being claimed. The same applies to claim 37, is this a database claim or a method of use claim?

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Kluss (6463419).

For claim 1,14-16,22,23,32,36,37,38, Kluss discloses a system and method where a person can enter into a charter with an owner of a vessel. The charterer information terminals are 20a-20c. The owner information terminals are 30a-30c. The storage unit is 45 and is disclosed as storing the same kind of information as claimed. The storage unit stores information related to vessels and information related to cargo that a person wishes to have shipped. The control unit is processor 41. The processor creates screens that allow for owners and charterers to input information and creates screens for displaying information to owners and charterers. See figure 1.

For claims 2,3,32,38, the enquiry information screen is satisfied by the disclosure in column 10, line 59 to column 11, line 3, and column 12, lines 39-42. Kluss discloses a screen/option that allows one to enter search criteria, and a search is done to identify vessels that satisfy the entered criteria. A specific ship can be identified (owner) or ships can be identified by matching the entered criteria.

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For claims 4-6, as these claims are best understood by the examiner, Kluss satisfies what is claimed. Kluss has various screens that allow for the input of data, display of data, allows for contacting another part to make an offer, allows negotiations to occur online, and screens for accepting the offers and printing out many kinds of standardized contracts.

For claims 7-13,18,20,32-35,21,38-41, see column 15, lines 59- column 16, line 19, which satisfies what is claimed. Kluss discloses a screen and option that allows for one to indicate an “expression of intention” to negotiate, and to send the same to the owner, as has been claimed. The owner can then respond (reply) by accepting, declining, or modifying (amended conditions) the received negotiation offer.

Negotiations occur as claimed.

For claims 30,31, see column 6, lines 45-65, where it is disclosed that history information concerning charters entered into by vessels is stored in database 48 of memory 45.

For claims 24,26, Kluss discloses that ship location is stored and can be displayed. See column 6, lines 36-41. Also see column 10, lines 21-23, where an “update ship position function” is disclosed.

For claims 25,27,29,38, the disclosure in column 6, lines 29-44 satisfies what is claimed. Information about various vessels is stored and user entered criteria can be used to search for vessels matching the entered criteria (i.e. column 12, lines 45-62).

For claim 28 see column 10, lines 1-4, where it is disclosed that there is an update function to update the data concerning the vessels and the ship specifications.

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For claims 17,19 (as best understood), Kluss discloses that contracts and standardized forms are stored as claimed. See column 6, lines 45-65, and see figure 4.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al. (6134534), Schiff et al. (20020082877 and 20030004760), Obrador et al. (20020049660), and Sernet (20020032632).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**DENNIS RUHL**  
**PRIMARY EXAMINER**